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JUL 26 2006

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In re Application of
Toshihiro Sadaoka et al :
Serial No.: 10/089,245 : PETITION DECISION
Filed: August 21, 2002 :
Attorney Docket No.: 050069-0111 :
:

This is in response to the petition under 37 CFR 1.181, filed May 17, 2006, requesting Supervisory review of an examiner's action relating to inventorship.

BACKGROUND

An abbreviated file history shows that applicants filed an Appeal Brief on December 15, 2004, in which rejections under 35 U.S.C. 102(f) over JP '820 and JP '248 were addressed as well as a separate rejection under 35 U.S.C. 103(a).

In view of the arguments presented in the Appeal Brief the examiner chose to reopen prosecution by mailing a non-Final Office action to applicants on March 30, 2005. The Office action again rejected claims 1-3 under 35 U.S.C. 112, second paragraph, as indefinite and under 35 U.S.C. 102(f) based on derivation over JP'820 and JP'248 and again required applicants to submit an affidavit attesting to the correct inventorship under 37 CFR 1.132. The examiner relied on M.P.E.P. 715.01(a) and 2137. Claims 1-3 were also rejected under 35 U.S.C. 103(a) as obvious over EP'723 in view of JP '336 and Fujii et al and JP'411.

Applicants replied on August 23, 2005, addressing each of the rejections above and arguing that an affidavit under 37 CFR 1.132 was unnecessary in view of applicants original declaration filed in the application in response to a Missing Parts letter.

The examiner mailed a Final Office action to applicants on November 17, 2005, maintaining the rejections under 35 U.S.C. 112, second paragraph, and 35 U.S.C. 103(a) for reasons of record. The examiner withdrew the rejection under 35 U.S.C. 102(f) for derivation, but maintained the requirement that an affidavit attesting to the inventorship be filed.

On February 17, 2006, applicants filed an amendment and argument amending claim 1 and arguing each of the rejections and requirement for an affidavit. In an Advisory Action mailed March 1, 2006, the examiner indicated entry of the amendment and withdrew the rejection under

35 U.S.C. 112, second paragraph, but maintained the other rejection under 35 U.S.C. 103(a) and requirement for an affidavit.

Applicants filed a Notice of Appeal on March 17, 2006, concurrently with this petition.

DISCUSSION

Applicants request that the Director require the examiner to withdraw the requirement for an affidavit under 37 CFR 1.132 to establish/confirm correct inventorship of this application in view of the subject matter of the claims being disclosed in the two Japanese application publications noted above which are not authored by the inventors of this application. Applicants argue that because there is no rejection under 35 U.S.C. 102(f) the examiner can no longer require an affidavit under 37 CFR 1.132 and that the originally filed declaration of the inventors is or should be sufficient to establish the correct inventorship.

The examiner relies on M.P.E.P. 2137 (and 715.01(a)) for the requirement for an affidavit.

M.P.E.P. 2137 states in part:

Where it can be shown that an applicant "derived" an invention from another, a rejection under 35 U.S.C. 102(f) is proper. *Ex parte Kusko*, 215 USPQ 972, 974 (Bd. App. 1981) ("most, if not all, determinations under section 102(f) involve the question of whether one party derived an invention from another").

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Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent so as to justify a rejection under 35 U.S.C. 102(f). However, it is incumbent upon the inventors named in the application, in reply to an inquiry regarding the appropriate inventorship under subsection (f), or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter invented by the applicant rather than derived from the author or patentee notwithstanding the authorship of the article or the inventorship of the patent. *In re Katz*, 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article regarding inventorship, and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the inventor" of the subject matter disclosed in the article and claimed in the application).

M.P.E.P. 715.01(a) states:

When subject matter, disclosed but not claimed in a patent or application publication filed jointly by S and another, is claimed in a later application filed by S, the joint patent or application publication is a valid reference >under 35 U.S.C. 102(a) or (e)< unless overcome by affidavit or declaration under 37 CFR 1.131 or an unequivocal declaration under 37 CFR 1.132 by S that he/she conceived or invented the subject matter disclosed in the patent or application publication

and relied on in the rejection. *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982). See MPEP § 716.10 for a discussion of the use of 37 CFR 1.132 affidavits or declarations to overcome rejections by establishing that the subject matter relied on in the patent or application publication was the invention of the applicant. Disclaimer by the other patentee or applicant of the application publication should not be required but, if submitted, may be accepted by the examiner.

It is clear that during the prosecution of this application the examiner raised an inquiry as to whether the inventors named herein invented the claimed subject matter of the application. The inquiry was properly raised under 35 U.S.C. 102(f). As noted above such an inquiry requires a reply by applicants as to the correct inventorship by means of an affidavit under 37 CFR 1.132, not just argument or assertion in a reply. However the section goes further to state that whether only an inquiry is made or when a formal rejection under 35 U.S.C. 102(f) is made a reply by applicants by means of an affidavit under 37 CFR 1.132 is required to overcome the inquiry or rejection. See bolded and underlined sections above. Such inquiry is not satisfied by the submission of the original declaration or oath (as the inquiry had not been made at that time) as the reply must include a showing which is not part of the oath or declaration required under 37 CFR 1.63.

In view of the above the examiner's actions in requiring an affidavit under 37 CFR 1.132, including a showing, to establish correctness of the inventorship is proper and will not be disturbed by the Director.

The petition is **DENIED**.

Applicants remain under obligation to file an appropriate Appeal Brief or take other appropriate action within the time period set under 37 CFR 1.192, or as extended under 37 CFR 1.136(a).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



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Director, Technology Center 1600